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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,180

12/02/2003

Simon Robert Walmsley

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

TRUVAN, LEYNNA THANH

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,180	<b>Applicant(s)</b> WALMSLEY ET AL.	
	<b>Examiner</b> Leynna T. Truvan	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/2/04 &amp; 9/8/08</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-3 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/2009 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-3 remains rejected over of Gilbert, et al. as the primary prior art. However, the secondary prior art is now in view of Matumoto, et al. necessitated by new grounds as submitted in the amendment (1/27/09). Although, Gilbert discloses the secret information in each chip being located in a different location in the EEPROM (flash) memory, but did not go into details in which the same secret information is stored in the (flash) memory of a plurality of the other chips. Therefore, it would have been obvious for a person of ordinary skills in the art to at the time the invention was made to combine Gilbert and Matumoto to teach the same secret information is stored in the flash memory of a plurality of the other chips because the burden of

work of the entities for sharing the cryptokeys is cut down tremendously (Matumoto - col.2, lines 42-46 and col.4, lines 23-27 and col.5, lines 58-63).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert, et al. (US 7,165,177), and further in view of Matumoto, et al. (US 5,0167,276).**

**As per claim 1:**

Gilbert discloses a plurality of integrated circuits, each of the integrated circuits (**col.1, lines 13-14 and col.4, lines 14-15**) comprising a processor and flash memory (**col.5, lines 39-40 and col.7, lines 41-53**), and including code for running identical software processes, wherein each of the integrated circuits also includes secret information used by the software process (**col.2, lines 4-10 and col.6, lines 11-14; secret information can broadly interpret as data that is protected and secure such that may involve authentication or verification process. Gilbert's secret key, authentication data, or certificate value (col.3, lines 1-28) which is referring to the claimed secret information.**), the secret information in each chip being located in a different location in the flash memory relative to locations [in which the same secret information is stored in the flash memory of a plurality of the other chips]. (**col.6, lines 18-22 and col.7, lines 55-65**)

Gilbert discloses the invention that provides hardwired logic or microprocessor integrated circuit chips with protection against fraud (col.1, lines 10-15). Gilbert discusses passing directly over each bit of the non-volatile memory by the number of bits determines to prevent any attempt at fraudulent replaying and the number of  $m$  is the same as the number of bits in the certificate  $S$  where the masked certificate  $S$  does not reveal any information on the certificate **(col.6, lines 18-67 and col.7, lines 1-25)**. Gilbert teaches an EEPROM which is a type of nonvolatile memory and that a flash memory is also a type of nonvolatile memory. Although, Gilbert discloses the secret information in each chip being located in a different location in the EEPROM (flash) memory, but did not go into details in which the same secret information is stored in the (flash) memory of a plurality of the other chips.

Matumoto discloses a shared cryptokey generation system provided with a secret algorithm generation apparatus which, under requirements determined among a plurality of entities sharing a cryptokey (col.2, lines 42-46 and col.4, lines 23-27). The plurality of entities and a plurality of cryptokey generation means which have memories which store at least the secret algorithms (col.2, lines 52-55 and col.4, lines 43-55). Matumoto discloses the procedure for generating the shared cryptokeys may be performed internally in the IC cards, etc., in addition to being performed by simply inputting the identifiers, so the burden of work of the entities for sharing the cryptokeys is cut down tremendously (col.5, lines 58-63).

Therefore, it would have been obvious for a person of ordinary skills in the art to at the time the invention was made to combine Gilbert and Matumoto to teach the same secret information is stored in the flash memory of a plurality of the other chips because the burden of

work of the entities for sharing the cryptokeys is cut down tremendously (Matumoto - col.2, lines 42-46 and col.4, lines 23-27 and col.5, lines 58-63).

**As per claim 2: see Gilbert on col.6, lines 18-22 and col.7, lines 55-65;** discussing a plurality of integrated circuits according to claim 1, wherein the code on each integrated circuit is such that the software process of each chip knows the location in memory via which the secret information is accessible.

**As per claim 3:** Gilbert discusses a method of manufacturing a plurality of the integrated circuits of claim 2, including the steps of: manufacturing a plurality of physical integrated circuits; and **(col.5, lines 21-23)** injecting, into the flash memory of each of the integrated circuits: code for running a software process; and the same secret information (Matumoto - col.5, lines 58-63); wherein the secret information is positioned in relatively different locations of the flash memories of the integrated circuits and the code on each integrated circuit is such that the software process of each integrated circuit knows the location in memory via which the secret information is accessible on that integrated circuit. **(col.6, lines 18-22 and col.7, lines 55-65)**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leynna T. Truvan whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. T. T./  
Examiner, Art Unit 2435

**/Kimyen Vu/  
Supervisory Patent Examiner, Art Unit 2435**